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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,378	03/01/2002	Robert Anthony Luciano JR.	GLF-01-001-CIP.1	4672
7590 01/11/2005			EXAMINER	
Russ F. Marsden c/o Sierra Design Group 300 Sierra Manor Drive Reno, NV 89511			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/087,378	Applicant(s) LUCIANO, ROBERT ANTHONY	
	Examiner Robert Mosser	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,13-20,22,26-28,30,33,34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,13-20,22,26-28,30,33,34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03-01-2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION



Claims 1-8, 10, 13-20, 22, 26-28, 30, 33, 34, 36 are pending.

This action is final.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 4-6, 8, 13, 16-20, 25-28, and 33-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140).

Regarding claims **1, 8, 20, and 33-34**. Helderma teaches the use of a golf ball identification system including targets comprising the entry, exit and guide portion as so claimed (Col 5:1-4), the use of RFID tags (Col 1:44-47), the use of two RFID readers

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per target (Col 4:60-63), a sign for allowing players to see their scores or standings (72), and a computer (server as so claimed) containing a data base for storing calculated player with associated player ball data (Col 1:48-52).

Helderman however is silent on the incorporation of game based on a pari-mutuel pool as so claimed. In a similar golf system Vincent teaches the use of a pari-mutuel pool (Col 1:25-28 & 3:49-54). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the pari-mutuel prize feature of Vincent in the golf game of Helderman in order reward players with exemplary games and/or achieving a hole-in-one as taught by Vincent (Col 1:11-28).

Regarding claim 4 and in addition to the above stated. The invention of Helderman teaches the use of the RFID reader in the dispensing of the golf ball, the assignment of said golf ball to a player, and the recording of the assignment at the time of dispensing which reads on the detection of a ball placed on the launch area (Col 5:5-15 & Col 5:38-50) wherein the processing/storage device (Elm 32) is understood as the claimed server.

Regarding claims 5, 6, 13, and 19, and in addition to the above stated. The invention of Helderman teaches the use of multiple inter connected processing/storage devices (Col 3:63-65 & Col 4:4-8 & Col 5:38-50) operable in communication with each other and where in one of the servers contains a database configured to hold data target in association with player data (account data) and where the results maybe displayed to all users with in view of a sign (Elm 72) or authorized users as understood.

Regarding claim **16, 17, and 25-28**, and in addition to the above stated. Helderma teaches the association with a set of balls to a players name (Specific players account) or a number (anonymous) as so claimed (Col 5:8-14).

Regarding claim **18** in addition to the above stated. The association of a set of ball IDs with an account further comprises associating a set of ball ID's into a group and allowing the group to be accessible using a ball ID contained there in, is deemed a matter of design choice wherein no stated problem solved or unexpected result obtained in the claimed invention that has not been provided for in the rejection of claims **5, 6, 13 and 19** above under the invention of Helderma/Vicent.

1. Claims **2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140) as applied to claim **1** in yet further view of Majkrzak et al (US 3,828,353).

The invention of Helderma/Vicent teaches the use of the RFID reader in the target assembly described above but is silent regarding the type of antennas used in the assembly. Majkrzak et al teaches a helix-coilform antenna as so claimed. It would have been obvious for one of ordinary skill in the art at the time of invention to have used the antenna of Majkrzak in the RFID readers of Helderma/Vicent in order conserve space in the target assembly.

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2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140) as applied to claim 1 in yet further view of Born et al (US 5,949,679)

In addition to the above stated, the invention of Helderma/Vincent teaches the use of a scoreboard (72) for displaying game related data but is silent on the use a WWW server or equivalently the Internet. Born et al however discloses the use of the internet for displaying and tracking the performance of players in golf related games (Col 19:44-52). It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated the web based performance tracking system of Born et al in the invention of Helderma/Vincent in order to increase access to player data.

3. Claims 10, 14, 15, 20, 22, 30, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helderma (US 5,743,815) in view of Vincent (US 5,102,140) as applied to claim 1 in yet further view of Takagi (US 5,513,841).

Regarding claims 10, 22, 30, and 36, in addition to the above stated. The invention of Helderma/Vincent is silent regarding the use of mobile targets in their golf game. Takagi however in a similar golf game teaches the use of mobile targets in a golf game related to competition (Figures 1, 7, 9, 10). It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated the moving targets of Takagi in the invention of Helderma/Vincent in order to allow competition at different ranges.

Regarding claim **14** in addition to the above stated. Takagi teaches the purchasing off balls from a vendor as a conventional method (Col 1:20-23).

Regarding claim **15** in addition to the above stated. The ownership of the balls by the player is deemed a matter of design choice wherein no stated problem solved or unexpected result obtained in the claimed invention that has not been provided for in the rejection of claim **14** above under the invention of Helderma/Vicent/Takagi.

Response to Arguments

Applicant's arguments filed 8-24-2004 have been fully considered but they are not persuasive.

I. Applicant argues that the interpretation of the prize of Vincent could not be a pari-mutuel prize and is "a mistake" (page 11 of the applicant's arguments filed August 24th, 2004). Applicant proceeds to include the following elements in support of their position.

a) Vincent discusses that the coins collected in Vincent's video-tape machine could be used to help fund a "hole-in-one" prize.

b) Vincent describes only a "prize" which has been interpreted by the applicant as a "static prize".

c) Vincent does not teach wagering of any kind including pari-mutuel play or a player funded progressive pool of any kind based on the above.

The previous elements and related interpretations are deemed deficient based on the following points.

A) With regards to the monies collected Vincent states,

"The automated system is coin-operated, which lends itself to the collection of money from those attempting to shoot a hole-in-one. Automated coin collection also makes available a "pool" of money from which to pay prize money to those who succeed in achieving this elusive goal." (Col 1:21-28)

This presents a system wherein the monies collected from player's attempting to shoot a hole-in-one are used to fund the prize contra to the applicant's presented "could be used to help fund". The applicant's interpretation seems to imply that this prize amount is in some manner removed from the player's deposit of monies and contra to the direct citation presented above. Further when the above is considered as a whole it is held to present the player with an opportunity to par take in the "elusive goal" for a fee and on success be rewarded a prize from the pool of monies paid by those who have paid but been unsuccessful. So far as Vincent has set forth a fee through the automated coin collection (wager) and those who succeed and are paid (winner) he has set forth at the bare minimum a wagering system.

B) Reviewing the citation presented above and

"If a hole-in-one or other specified event should occur, the golfer can then claim the prize." (Col 3:47-49),
the examiner notes the only reference to the prize amount as being presented in the citation of column one presented above. The citation as shown only suggests the

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collection of monies from those attempting a hole-in-one and the dissemination of those monies to those who achieve the goal. Thence there is no support for the association of static with prize money as presented by applicant.

C) Pari-mutuel or equivalent pari-mutual systems is defined by the Michigan Gaming Control Board as

Pari-Mutuel Systems: A form of gambling where the gaming establishment pools the bets of the players and does not risk any of its own money. The winnings are taken from the pool of bets. The value of winnings is decided on by the pattern of bets placed by the players (<http://www.michigan gaming.com/Glossary.html>).

As no previous definition for the term “pari-mutual” has been set forth the above is provided. As set forth by at least the above definition and sections A through B of the response to arguments the system of Vincent is understood as disclosing pari-mutual play.

Regarding the applicant’s challenge of USC 103 motivation to combine the Vincent and Helderman references the applicant is first reminded of the following elements.

The applicant’s citation of 2144.03 refers to “official notice”, which is not incorporated into the cited rejection claims. For future reference only statements of the nature as “The examiner gives official notice that pari-mutual wagering is old and well known sports” wherein no evidence is relied upon besides common knowledge maybe challenged in the manner proposed by the applicant when they refer to presented claim limitations. In this case the elements of the claimed invention are taught by the prior art

and hence no "official notice" is utilized. In the interest of furthering prosecution and remedying any possible typographical error the following is provided to clarify the presented rejection and the basis of motivation to combine associated therewith.

First, the statement of obviousness as originally presented reads "It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the pari-mutuel prize feature of Vincent in the golf game of Helderman in order reward players with exemplary games and/or achieving a hole-in-one" and includes a motivation to combine omitted in the applicant's presentation of the combination.

Second, the MPEP states the following with regards to forming a substitutive motivation for combination

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. (MPEP § 2105).

Third and finally, the presented motivation of "rewarding players with exemplary games and/or achieving a hole-in-one" through the inclusion of a wager and verification system" meets the required "knowledge generally available to one of ordinary skill in the

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art, to modify the reference or to combine reference teachings" to reward players as taught by the Vincent (now cited for clarity) as well as being extremely well known in the art of wagering devices. Wherein the inclusion of a wager and a possible reward based on that wager forms the inherent basis for the gaming industry.

Remaining points of the previous office action are not addressed and hence understood as being acquiesced by the applicant.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boylan et al (US 5,505,457) teaches a progressive wagering game including a gold motif.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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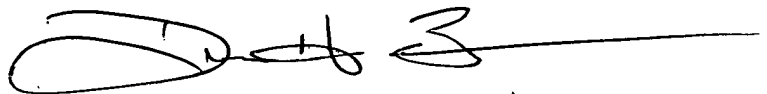
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700